

### **REMARKS**

The amendment to claim 166 made herein was unintentionally omitted from the amendment dated April 30, 2007. The same amendment was previously made to claim 97 and upon entry of this Supplement Amendment, all claims are consistent.

Also in the amendment dated April 30, 2007, the applicant notes a typographical error in the response to the rejection of claims under §102(e) and respectfully requests that this supplemental amendment be entered to correct this error. Specifically, the paragraph at the top of page 5 should read to include the **bold and underlined** correction as follows:

"As noted the applicant refers the examiner to the specific language of claim 97 which recites "microchips having oligonucleotides with different sequences attached thereto." Thus, the examiner is incorrect in asserting that the claims **do not** require that the probes differ. Regardless of the actual number of oligonucleotides in the on the microchip, the limitation that oligonucleotides with different sequences are present is distinct from the disclosure of Winkler and the rejection must therefore be withdrawn."

#### The double patenting rejection

The examiner previously rejected claim 97 and 157 through 175 on the ground of obviousness type double patenting as being directed to subject matter that is assertedly not patentably distinct from the subject matter of claims 1 through 8 in US Patent No. 6,383,742 (hereinafter the '742 patent). While not admitting to the propriety of the examiner's rejection, applicant previously filed a terminal disclaimer in order to obviate the rejection.

It has now been brought to the undersigned's attention that the instant application and US Patent No. 6,383,742 are owned by separate and distinct entities. Thus, the terminal disclaimer previously filed does not obviate the double patenting rejection and is herein withdrawn. Moreover, the applicant submits that the claims of the '742 patent do not render obvious the subject matter of the instant claims.

According to the MPEP section 804;

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. General

Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279, 23  
USPQ2d 1839, 1846 (Fed. Cir. 1992).

Whether the analysis is such a test is one-way or two-way is dependent on several factors.

Again according to the MPEP section 804;

...even if the application at issue is the earlier filed application, only a one-way determination of obviousness is needed to support a double patenting rejection in the absence of a finding: (A) of administrative delay on the part of the Office causing delay in prosecution of the earlier filed application; and (B) that applicant could not have filed the conflicting claims in a single (i.e., the earlier filed) application.

Here, the instant application was filed as a PCT application on August 27, 1994, claiming priority of an earlier application filed August 27, 1993. The application underlying the '742 patent was filed August 15, 1997, claiming priority through a series of continuation-in-part applications to a first application filed January 16, 1997. Thus absent a finding of administrative delay by the Patent Office and a finding that the patent claims at issue could not have been presented in the instant application, a one-way test of obviousness is inappropriate.

A review of the present file clearly demonstrates that the this application was not acted on by the Patent Office between an Office Action mailed May 28, 1997 and the next office action mailed November 25, 2005. If the examiner disputes that this delay constitutes *prima facie* evidence of administrative delay on the part of the Patent Office, evidentiary proof in rebuttal is requested.

As to the second test, the applicant admits that the instant application does not provide support for the subject matter of claims in the in the '742 patent over which the examiner makes this rejection. If the examiner can point to support in the instant application that would permit entry of the referenced '742 claims into this application, precise advice of the same is requested.

Having shown that a one-way test is inappropriate in this instance, we turn back to the MPEP section 804 for guidance through an appropriate two-way test:

If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998)

...

When making a two-way obviousness determination where appropriate, it is necessary to apply the Graham obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Accordingly, if one test in the two-way analysis fails, obviousness-type double patenting is inappropriate and the examiner must provide some fundamental reason to the contrary.

Here, the two-way test fails when the instant claims are prior art to claims in the '742 patent. The instant claims, in the broadest sense, are directed to an array of microchips on a support wherein the microchips are separated by a barrier and the microchips have oligonucleotides with different sequence attached thereto. The subject matter of the '742 patent claims, also in the broadest sense, recite a three-dimensional array of layered sheets, each sheet having a two-dimensional array of probes. Even if it is asserted that the instant microchip array is similar to a single sheet in the referenced three-dimensional array, nothing in the instant claims suggests that layering the claimed supports would be feasible, logistically functional, or advantageous in any way. Moreover, without some teaching of how to make and use such a three-dimensional array, the worker would have no motivation to produce it when a simple, two-dimensional support provides none of the technical difficulties that come with a three-dimensional array. The construction of the three dimensional array is not simply a variant obvious to the creative inventor; it is a technological step that requires operational conditions considerably more detailed than those used for the instantly claimed support, and these differences are described in the '742 patent.

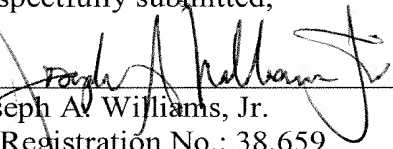
Thus, in a required two-way test for obvious the instant claims fail to render obvious the subject matter of the '742 claims, and as a consequence, an obviousness-type double patenting rejection is inappropriate and must be withdrawn.

**CONCLUSION**

In view of the amendments and remarks made herein, the applicant submits that all claims are in condition for allowance and requests notification of the same.

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Respectfully submitted,

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